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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,201	09/08/2003	Valerie De La Poterie	230172US0	7480

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER	
VENKAT, JYOTHSNA A	
ART UNIT	**PAPER NUMBER**
1615	

NOTIFICATION DATE	DELIVERY MODE
08/28/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No.	Applicant(s)	
	10/656,201	DE LA POTERIE ET AL.	
	Examiner	Art Unit	
	JYOTHSNA A. VENKAT Ph. D	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 June 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *36-68* is/are pending in the application.

4a) Of the above claim(s) *45-49 and 66-68* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *36-44 and 50-65* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date 4/2/05; 9/1/04; 6/9/04; 3/1/04
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of election, and preliminary amendment filed on 2/5/07, and 9/8/03 respectively. Preliminary amendment canceled claims 1-35 and added claims 36-68. Receipt is acknowledged of IDS filed on 3/1/04, 6/29/04, 9/1/04 and 4/7/05.Receipt is also acknowledged of Kester wax k 82P as the species belonging to formula I. Claims 36-68 are pending in the application and the status of the application is as follows:

Election/Restrictions

Applicant's election with traverse of group I in the reply filed on 2/5/07 is acknowledged. The traversal is on the ground(s) that the search for compositions and methods would occur in the same classes/subclasses given the fact that the compositions in Group I compositions are essentially the same compositions used in the Groups II and III methods thus, the same classes/subclasses would be searched because the same compositions are relevant to Group I and Group II and group III claims -- no burden would be placed on the Office in searching and/or examining all claims together. This is not found persuasive because art anticipating a composition claim would not anticipate a method of use claim, search on NPL and patent literature for both the composition and method of use is serious search burden and additionally the restriction between groups I and II-III is in compliance with MPEP 806.05 (h).

The requirement is still deemed proper and is therefore made FINAL.

Claims 66-68 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 4/23/07.

With respect to restriction between species applicants argue that the identified species are related by operation and/or effect and it is not a search burden to examine all the species and therefore division of each of these species is unsupported and improper.

This is not persuasive as the structuring agent is a wax or the structuring agent is a combination of at least one specific compound with at least one oil. See below for different specific compounds and different oil.

46. (New) The composition according to Claim 45, wherein the specific compound is selected from the group consisting of semi-crystalline polymers, fatty-phase rheological agents and mixtures thereof.

47. (New) The composition according to Claim 45, wherein the oil is selected from the group consisting of volatile and non-volatile hydrocarbon oils, silicone oils, fluoro oils, and mixtures thereof.

The various combinations of specific compounds and oils are serious search burden and the species belonging to structuring agent are not mutually exclusive and art anticipating or rendering obvious wax would not anticipate or render obvious structuring agent, which is a combination of specific compound and oil.

Claims 45-49 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 4/23/07 and 5/16/07.

Claims 36-44 and 50-65 are pending in the claims and the generic claims will be examined to the extent that it reads on Kester wax as the structuring agent.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 36-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

What is meant by dry solids extract? The specification does not define the meaning of dry solids extract. What is meant by extract? This expression is ambiguous and it is unclear as to applicant's intent.

Claim Rejections - 35 USC § 102

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 36-44 and 50-65 are rejected under 35 U.S.C. 102(e) as being anticipated by PGPUB US 2004/0137020A1 ('020).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

The filing date of the instant application is 9/8/03 and applicants are not accorded benefit of provisional application since the provisional application is in French.

Claims 36-38 are rejected on the basis that the composition has wax greater than 47% since wax is a solid.

See paragraphs 2-5 for use of the composition. See paragraphs 26-28 for tacky wax, tack property, hardness property, see paragraphs 34-37 and see specially paragraph 37 for claimed species. See paragraph 42 for the range. See paragraphs 81-83 for claimed solvents, see paragraphs 107-109 for claimed fatty phase, see paragraphs 116-152 for the claimed film forming polymer and various film forming polymers, see paragraphs 166-170 for claimed dyestuff and see paragraph 171 for claimed additives.

Claims 36-44 and 50-65 are rejected under 35 U.S.C. 102(e) as being anticipated by PGPUB US 2004/0137021A1 ('020).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

The filing date of the instant application is 9/8/03 and applicants are not accorded benefit of provisional application since the provisional application is in French.

Claims 36-38 are rejected on the basis that the composition has wax greater than 45% since wax is a solid.

See paragraphs 2-5 for use of the composition. See paragraphs 27-29 for tacky wax, tack property, hardness property, see paragraphs 36-38 and see specially paragraph 39 for claimed species. See paragraph 43 for the range. See paragraphs 81-83 for claimed solvents, see paragraphs 85-108 for claimed fatty phase, see paragraphs 115-154 for the claimed film forming polymer and various film forming polymers, see paragraphs 167-171 for claimed dyestuff and see paragraph 172 for claimed additives.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 36-44 and 50-65 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 32-38 and 45-58 of copending Application No. 10/656,278. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

In the copending application the Kester wax is more than 45% by weight and in the instant application the Kester wax is more than 47% by weight. More than 45 % includes more than 47% and the scope of the claims would be identical in both the applications.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 36-44 and 50-65 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 32-38 and 45-58 of copending Application No. 10/656,278. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would be obvious to use more than 45% of Kester wax of co-pending application and use more than 47% in the instant application expecting the composition to be useful in cosmetics.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JYOTHSNA A VENKAT Ph. D
Primary Examiner
Art Unit 1615

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